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CAPSTONE LAW GROUP LLP 1810 GATEWAY DRIVE SUITE 260 SAN MATEO, CA 94404			HAYES, JOHN W	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/648,102	COOPER, JONATHAN D. <i>MW</i>	
	<b>Examiner</b>	<b>Art Unit</b>	3621
	John W Hayes		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 March 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27,36-45,47,48 and 50-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27,36-45,47,48 and 50-58 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Status of Claims***

1. Applicant has previously canceled claims 28-35, 46 and 49. Thus, claims 1-27, 36-45, 47-48 and 50-58 remain pending and are again presented for examination.

### ***Response to Arguments***

2. Applicant's arguments filed 11 March 2004 have been fully considered but are not found to be persuasive.

3. Applicant argues (with respect to claims 15, 36-37 and 50-51) that Downing does not in any way teach a mechanism for providing ATM cards to the recipient of a money transfer transaction. Examiner notes that Downing does disclose that the sender uses a card with a PIN to initiate a transfer of money (Col. 6, lines 18-25) using ATM networks to a recipient wherein the recipient does not need a card or any other medium to receive the money. Examiner submits, however, that the rejection is based on a combination of the references to Downing and Picciallo wherein Picciallo discloses configuring a computer readable medium to enable the transfer of money. FP for attacking references individually.

4. Applicant further asserts that Downing and Picciallo solve different problems and thus any motivation to combine these references is lacking. Examiner respectfully disagrees and submits that since both references to Downing and Picciallo are related to transferring money from one individual to another using different methods, it would have been obvious to one having ordinary skill in the art to use the teachings of either reference to incorporate useful features.

5. Applicant also asserts that Picciallo is not enabling with respect to disclosures related to ATMs. Examiner respectfully disagrees and submits that Picciallo discloses that the system of the invention uses ATMs to enable the recipient of the money transfer to withdraw funds from an ATM machine. Examiner also submits that ATM machines and networks were notoriously well known at the time of both references to Downing and Picciallo and it there would be no need to provide a detailed disclosure related to ATM

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machines and networks since this technology was so well known at the time and was readily understood by one having ordinary skill in the art.

6. With respect to claims 1, 5-6, 10-11, 18-19, 26-27 and 36-43, applicant asserts that neither Downing nor Picciallo disclose a transaction fulfillment center for controlling the delivery of ATM cards to recipients. Examiner respectfully disagrees and submits that Picciallo discloses that a magnetically encoded card is issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient. Examiner submits, however, that there are many different ways of delivering items to individuals. Picciallo provides two examples of these, however, examiner submits that this does not necessarily exclude all other well known methods for delivering something to a recipient such as using a commercial vendor to hold the item for pickup by the recipient.

7. With respect to claims 7-8, 20-21 and 24-27, applicant acknowledges that certain activation methods may have been known, however, asserts that examiner has not identified a teaching within the four corners of Downing and Piciallo that discloses an activation method. Examiner submits that it is not necessary to identify a teaching within the Downing and Piciallo references when relying on Official Notice. Examiner also submits that reasonable motivation for combining the references of Downing and Piciallo with these well known methods for activating a card was given in the previous rejection and is repeated below. Examiner further submits that it is not required that the motivation must come from Downing and Piciallo. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

8. With respect to claims 9 and 39, applicant asserts that the identifier taught by Piciallo relates to the location of the funds, not the transaction. Examiner respectfully disagrees and submits that Piciallo teaches, as applicant has pointed out, an identifier correlated to a secondary file and the secondary file is related to consumer transaction information. Piciallo does not mention that the identifier only relates to

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the location of the funds, but rather is related to an account balance as a result of transaction. Claim 9 simply states that the serial number is associated with consumer transaction information and examiner submits that Pciallo teaches at least that the identifier is associated with transaction information.

9. With respect to claim 14, applicant has challenged Examiner's use of Official Notice. Examiner cites the reference to Hall, U.S. Patent No. 6,026,375. Hall discloses a method for processing orders from customers and teaches that the system will determine the customer's location and further determine, based on the customer's location, a local facility that can satisfy the customer's order. The service then transmits the order to the local facility and schedules the fulfillment of the order to coincide with the customer's arrival at the local facility (Abstract). Thus, Hall discloses an algorithm that returns the most appropriate delivery location based on certain consumer information or criteria. Examiner submits that it would have been obvious to modify the methods of Downing and Pciallo and incorporate the ability to determine an appropriate delivery location based on certain consumer criteria in view of this teaching by Hall to enable a flexible and more convenient means for delivering the item to the consumer. Examiner further submits that the reference to Hall is only being cited to substantiate the previous Official Notice statement by the examiner, does not result in a new basis for rejection, and therefore, this rejection will be made final.

#### *Drawings*

10. This application was filed with informal drawings that are acceptable for examination purposes.

When the application is allowed, applicant will be required to submit new formal drawings.

#### *Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claim 1-13, 15-27, 36-45, 47-48 and 54-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al, U.S. Patent No. 5,963,647 in view of Picciallo, U.S. Patent No. 6,044,360.

As per Claims 1, 5 and 38, Downing discloses a computer system to facilitate secure money transfer transactions between sender consumers and recipient consumers, said computer system comprising:

- a transaction control center for receiving information from a sender consumer in order to initiate a secure money transfer with a recipient consumer (Figures 2-3; Col. 5, lines 47-60; Col. 6, lines 18-30);
- a transaction database configured to store transaction data associated with said secure money transfer, said transaction data associated with said secure money transfer including consumer transaction information, a recipient address, and a unique security identifier for said secure money transfer, said transaction database being in communication with said transaction control center (Col. 5, lines 60-65; Col. 6, lines 50-65; Col. 8 line 35-Col. 9 line 20); and
- a transaction fulfillment center being in communication with said transaction control center, said transaction fulfillment center utilized by said recipient consumer to complete said secure money transfer (Col. 7, lines 18-28).

Downing, however, fails to explicitly disclose the use of a computer readable medium configured to enable the completion of the secure money transfer and wherein the computer readable medium is delivered to the recipient consumer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14 and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the

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recipient as taught by Picciallo, or even to a third party for pickup by the recipient, thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per Claims 2-4, Downing further discloses wherein the transaction control center includes a telemarketing operation capable of receiving a secure money transfer telephone order from said sender consumer or a web site available on the Internet, or by using an ATM (Figure 2; Figure 5, lines 23-46).

As per Claims 6, 10-11 and 40-43, Downing further disclose the use of one or more of a network of third party commercial vendors who have devices such as ATM with dedicated communication systems that are always available for fulfilling the money transfer (Figure 2; Col. 5, lines 23-46).

As per Claims 7-8, Downing and Picciallo fail to explicitly disclose activation of the computer readable medium through the use of toll free telephone lines or via Internet communications. Examiner takes Official Notice that activating credit/debit/ATM cards through various means was well known in the art at the time of applicant's claimed invention and it would have been obvious to enable the activation of these cards through these means in order to provide additional security measures. As was well known in the art, this feature would prevent the unauthorized use of a lost or stolen card by an unauthorized person.

As per Claims 9 and 39, Downing fails to disclose the use of a computer readable medium or storing a pre-assigned serial number associated with consumer transaction information. Picciallo discloses the use of a computer readable medium as well as an identifier encoded on the magnetic card which is associated with the transaction information (Col. 11, lines 35-40). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and

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use a computer readable medium encoded with an identifier such as a pre-assigned serial number as taught by Picciallo in order to link the card to a particular transaction or account.

As per Claims 12-13, 16-19 and 44-45, Downing discloses a computer implemented method for facilitating a secure money transfer transaction between a sender consumer and a recipient consumer, said computer implemented method comprising the steps of:

- a) obtaining transaction payment information associated with said sender consumer (Figures 2-3; Col. 6, lines 18-30);
- b) obtaining address information for said recipient consumer (Col. 6, lines 25-30);
- c) defining a unique security identifier associated with said secure money transfer (Col. 6, lines 20-25);
- d) entering the information in steps a)-c) into the transaction database (Col. 5, lines 60-65; Col. 6, lines 50-65; Col. 8 line 35-Col. 9 line 20)
- e) assigning a serial number to the consumer transaction and information (Figure 4; Col. 6, lines 60-65);
- g) providing said recipient consumer with said unique security identifier (Col. 7, lines 6-18) and;
- i) enabling the recipient consumer to withdraw cash from financial networks using the unique security identifier (Col. 7, lines 18-28; Col. 12, lines 10-45).

Downing, however, fails to explicitly disclose configuring a magnetically encoded computer readable medium to said secure money transfer, providing the medium to the recipient said computer readable medium utilized by said recipient consumer in completing said secure money transfer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the

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ability to configure a computer readable medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per Claim 15, Downing further discloses a computer implemented method as recited in claim 12, wherein the said act of facilitating the withdrawal of cash by a recipient consumer configured computer readable medium further comprises the acts of:

- (a) entering the consumer transaction data in a transaction database (Col. 8, line 25-Col. 9 line 20).
- (b) entering the recipient consumer request into a transaction database, which may include a serial number for a configured computer readable medium (Col. 12, lines 19-26).
- (c) comparing the recipient consumer information with the stored consumer transaction data to determine if the recipient consumer information matches the consumer transaction information and if it is valid (Col. 12, lines 19-55);
- (d) if there is a match, then the transaction database associates the recipient consumer information with the consumer transaction data, records the transaction, and signals a financial network that the configured computer readable medium is enabled to withdraw cash from ATM networks (Col. 12, lines 19-55); and
- (e) if there is not a match the consumer transaction information then the transaction database requests new information from the recipient consumer (Col. 12, lines 23-38)

Again, Downing fails to explicitly disclose the use of a computer readable medium, however, this is addressed above.

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As per Claims 20-21 and 24-27, Downing and Picciallo fail to explicitly disclose activation of the computer readable medium through the use of toll free telephone lines or via Internet communications. Examiner takes Official Notice that activating credit/debit/ATM cards through various means was well known in the art at the time of applicant's claimed invention and it would have been obvious to enable the activation of these cards through these means in order to provide additional security measures. As was well known in the art, this feature would prevent the unauthorized use of a lost or stolen card by an unauthorized person.

As per Claims 22-23, Downing further discloses wherein the unique security identifier is provided by the sender consumer (Col. 6, lines 20-27; Col. 7, lines 7-12).

As per Claims 36-37, Downing further discloses a computer implemented method as recited in claim 12, wherein the said act of activating of cash by a recipient consumer configured computer readable medium further comprises the acts of:

- (a) entering the recipient consumer request into a transaction database, which may include a serial number (Col. 12, lines 19-26).
- (b) determining the validity of the activation request (Col. 12, lines 19-55);
- (c) if the activation is valid, then the transaction database signals a financial network that the configured computer readable medium is active (Col. 12, lines 19-55); and
- (d) if the activation is not valid, then the transaction database requests new information from the recipient consumer (Col. 12, lines 23-38)

Again, Downing fails to explicitly disclose the use of a computer readable medium, however, this is addressed above.

As per Claims 47-48, Downing discloses an automated process for sending money from a first location to a second location comprising:

- a) receiving a request for a secure money transfer from a requestor (Col. 6, lines 18-30);

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b) receiving information associated with a recipient for the secure money transfer including an amount of the money transfer (Col. 6, lines 18-30);

d) assigning an authorization to the secure money transfer for using the secure money transfer instrument in automated teller machines wherein the authorization includes an access code in order to receive money at the ATM (Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45);

e) wherein the secure money transfer is used to transfer money from a requestor located in a first country to a recipient located in a second country, and wherein

Downing, however, fails to explicitly disclose transferring the amount to a secure money transfer instrument, providing the medium to the recipient said computer readable medium utilized by said recipient consumer in completing said secure money transfer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per Claims 54-55, Downing discloses an automatic money transfer system for transferring money from a donor to a donee comprising:

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- a) an automated server system for facilitating the secure transfer of money from a donor to a donee, the automated server system being operative to allocate funds for secure transfer and to assign a security code (Col. 6, lines 18-30);
- b) a data storage device for recording the secure transfer (Col. 5, lines 60-65; Col. 6, lines 50-65; Col. 8 line 35-Col. 9 line 20);
- c) enabling the donee to access the funds from an ATM using the security code (Col. 7, lines 18-28; Col. 12, lines 10-45).

Downing, however, fails to explicitly disclose allocating funds to a portable secure transfer instrument including machine readable information, providing the instrument to the recipient enabling said recipient consumer to complete said secure money transfer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per Claim 56, Downing further discloses wherein the security code must be manually entered on the ATM by the donee or recipient to receive money (Col. 12, lines 17-23).

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As per Claim 57, Downing fails to further disclose using an automated communications system for providing the security code to the donee. Downing, however, does disclose that the sender is responsible for contacting the recipient and providing the secret code to the recipient as well as other information. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that the sender may use any communication means available in order to convey this information to the recipient, including an automated communications system such as e-mail as a matter of convenience.

As per Claim 58, Downing further discloses wherein the amount is provided by the requestor in a first currency and provided to the recipient in second currency, wherein the first currency and the second currency are of different nationalities (Col. 7, lines 44-67).

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downing, U.S. Patent No. 5,963,647 and Picciallo, U.S. Patent No. 6,044,360, and applied above and further in view of Hall et al, U.S. Patent No. 6,026,375.

As per Claim 14, Downing and Picciallo fail to specifically disclose wherein the act of determining contact information for the recipient includes the act of selecting the most appropriate delivery location by implementing an algorithm that returns the most appropriate delivery location based on criteria, comprising but not limited to: (a) the geographic location of recipient, (b) the desired hours of pick-up location, and (c) the desired features of pick-up location. Hall discloses a method for processing orders from customers and teaches that the system will determine the customer's location and further determine, based on the customer's location, a local facility that can satisfy the customer's order. The service then transmits the order to the local facility and schedules the fulfillment of the order to coincide with the customer's arrival at the local facility (Abstract). Thus, Hall discloses an algorithm that returns the most appropriate delivery location based on certain consumer information or criteria. Examiner submits that it would have been obvious to modify the methods of Downing and Piciallo and incorporate the ability to

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determine an appropriate delivery location based on certain consumer criteria in view of this teaching by Hall to enable a flexible and more convenient means for delivering the item to the consumer. The motivation would be to provide additional conveniences to the recipient so that he/she does not have to travel long distances to receive the item or can receive the item at any time of day.

14. Claims 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing, U.S. Patent No. 5,963,647 and Picciallo, U.S. Patent No. 6,044,360, and applied above and further in view of Corder et al, U.S. Patent No. 5,936,221.

As per Claim 50,

- a) receiving a request for a secure money transfer from a requestor (Col. 6, lines 18-30);
- b) receiving information associated with a recipient for the secure money transfer including an amount of the money transfer (Col. 6, lines 18-30);
- d) assigning an authorization to the secure money transfer for using the secure money transfer instrument in automated teller machines wherein the authorization includes an access code in order to receive money at the ATM (Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45);
- e) wherein the secure money transfer is used to transfer money from a requestor located in a first country to a recipient located in a second country (Col. 7, lines 29-67).

Downing, however, fails to explicitly disclose transferring the amount to a secure money transfer instrument, providing the medium to the recipient said computer readable medium utilized by said recipient consumer in completing said secure money transfer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable

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medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

Downing further discloses wherein the secure money transfer is used to transfer money from the requester located in a first country to a recipient located in a second country as described above. Although it may have been obvious that the requestor may be capable of adding additional funds to the secure money transfer using the process as disclosed by Downing, this is not explicitly disclosed. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and include the ability to add additional funds to the secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

As per Claims 51-53, March discloses an automated process for sending money from a first location to a second location comprising:

- a) receiving a request for a secure money transfer from a requestor indicating a destination for the transfer and an amount for the transfer via a communications network (Col. 6, lines 18-30; Col. 7, lines 29-67);
- b) assigning an authorization code to the ATM card (Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45); and

Downing, however, fails to explicitly disclose transferring the amount to an ATM card, providing the card to the recipient and said card utilized by said recipient consumer in completing said secure money transfer. Picciallo discloses a third party credit card/ATM card method wherein an account holder

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can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

Although it may have been obvious that the requestor may be capable of adding additional funds to the secure money transfer using the process as disclosed by Downing, this is not explicitly disclosed. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and include the ability to add additional funds to the secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

### **Conclusion**

**15. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

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shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**16. Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

17. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Marcus et al discloses many features of applicant's invention, however, without the need to have a card to activate the dispensing terminal
- Stoutenburg et al disclose a method for performing money transfers through a TCP/IP network including establishing a desired amount to be transferred, establishing a code that corresponds to the transaction details and transmitting the code from the sender to the recipient
- Rizzo et al disclose a method for cash transfers that allows an originator to set up a transaction using a telephone or website and transfer money to a recipient who uses an ATM card to receive the funds
- Downing et al disclose a method for transferring funds from an account to an individual and teach that an originator can transfer an amount to a cash access file which can be accessed 24 hours a day wherein access is achieved by the recipient entering a codeword selected by the sender along with a transaction code and wherein the recipient can receive funds through an ATM even without using a card to access the system.

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- Ito et al disclose a method of transferring funds from a sender to a receiver using a communications network and e-mail.
- Farris et al disclose a method for transferring funds from a customer to a patron by depositing cash into a kiosk, providing a security code to the customer who then provides this code to a patron who inputs the code into a kiosk in order to receive the funds.
- Cucinotta et al disclose a method for holding and dispensing cash upon demand at a remote location
- Jennings et al disclose a method for transferring funds by allowing funds to be transferred instantly to an account so that they are available to a beneficiary
- Davis et al disclose a method for activating cards at the point of distribution.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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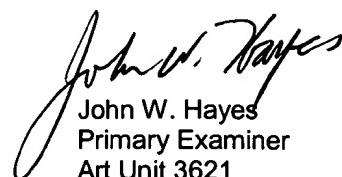
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**(703) 746-5531 [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]**

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



John W. Hayes  
Primary Examiner  
Art Unit 3621

May 17, 2004